



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,923	03/01/2004	Nancy C. Frye	063293.0110	1435

5073 7590 06/28/2005

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,923

Applicant(s)

FRYE, NANCY C.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Applicant's election of Species IX, figure 14 in the reply filed on 9/03/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 6, 7, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/3/04. There is no cavity as claimed in claim 6 shown in the elected species. The toe section shown in the elected species is not short of the forward periphery as claimed in claim 7, the elected species shown in figure 14 clearly is shown at extending to the front extent of the toe of the shoe and therefore claim 7 is not disclosed in figure 14. Claim 9 appears to claim an undisclosed species which is clearly not shown in figure 14, the elected species. The fact that these claims depend from a generic claim does not cause these claims to read on the elected species and therefore these claims continue to be withdrawn.

Drawings

3. The drawings were received on 1/7/05. These drawings are not entered because they contain new matter, i.e. the thickness, shape, exact location, etc. of the midsole is considered to be new matter. In response applicants' arguments directed towards the new matter added to the drawings in order to show the midsole, it is noted that it is applicants' responsibility when originally filing the application to ensure that all claimed

elements are clearly shown in the drawings, the addition of elements at a later date in most cases does add new matter and will not be entered.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the midsole(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the specification states that 824 is a point at $\frac{1}{2}$ the length of the shoe, however the point at 824 in figure 14 appears to be clearly in the forefoot portion of the shoe, this is confusing. Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. Claims 1-5, 8, and 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "having a forward toe section and a rear heel section that place...", claims 2 and 10 in their entirety, in claim 11 the phrase "having a forward toe section and a rear heel section that place...", in claim 16 the phrase "having a forward toe section and a rear heel section that place..." are functional, vague, indefinite, and

incomplete because it is not clear what structural limitations applicant intends to encompass with such language, especially with reference to claims 2 and 10 it is not clear what further structural limitations applicant intends to encompass with such language.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 10, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lodispoto (4681114).

9. Claims 1-5, and 10-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Snabb (5491912).

First it is noted that the elected species was first disclosed in parent application 09/688308 filed 10/13/2000 and therefore the subject matter is only given the benefit date of 10/13/2000. Snabb shows a shoe with an upper, insole, and sole (figure 2) with the claimed shape (described in column 3 lines 41-50 and column 4 lines 35-40). In reference to claim 4, the location shown and described by Snabb appears to be the same location shown in applicants' figure 14 and is considered to be "substantially halfway" as claimed.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5, 8, 10-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (4934073).

Robinson shows a shoe with an upper (34), insole (formed by elements 22 and 30), and an outsole 12 substantially as claimed except for the insole be a single piece layer of the shoe. It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally form elements 22 and 30, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

In reference to claims 8, 14, and 16-20, Robinson as modified above shows a shoe substantially as claimed except for a plurality of midsoles located between the insole and outsole. Official notice is taken that the use of midsoles between insoles and outsole is extremely well known and conventional and since applicant has not shown such or provided any detail of such, it is assumed that applicant is claiming a well known and conventional midsole(s). It would have been obvious to provide a midsole(s) in the shoe of Robinson is well known and conventional to increase comfort and cushioning.

12. Claims 8, 14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snabb.

Snabb shows a shoe substantially as claimed except for a plurality of midsoles located between the insole and outsole. Official notice is taken that the use of midsoles between insoles and outsole is extremely well known and conventional and since applicant has not shown such or provided any detail of such, it is assumed that applicant is claiming a well known and conventional midsole(s). It would have been obvious to provide a midsole(s) in the shoe of Snabb is well known and conventional to increase comfort and cushioning.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Robinson or Snabb.

Robinson or Snabb as discussed above shows a shoe with an insole substantially as claimed except for the insole being "removable". Official notice is taken that it is well known and conventional to allow insoles to be removable to allow orthotic inserts to be used, insoles and/or shoes to be laundered, to adjust worn elements, etc. It would have been obvious to make the insole removable as is well known and conventional in the shoe of either Robinson or Snabb to provide any of the known benefits of removability as discussed above.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 3728

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-5, 8, and 10-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,131,315 in view of either Lodispoto, Robinson, or Borgeas (3990159). Patent '315 claims a shoe with a sole which has a uniform thickness in the forefoot and a sloped heel surface to hold the heel lower than the forefoot in relation to the ground surface. Either Lodispoto, Robinson, or Borgeas teaches varying the thickness of an insole layer of the sole to provide sloped surfaces to reorient the foot. It would have been obvious to provide the thickness variation/sloped surfaces in the insole layer as taught by either Lodispoto, Robinson, or Borgeas in the shoe claimed in Patent '315 to allow a prefabricated shoe to be easily adjusted.

Response to Arguments

16. Applicant's arguments filed 6/2/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Lodispoto, Lodispoto clearly shows that the insole has a heel portion at number 24 which is thinner than the forefoot portion and therefore the insole of Lodispoto is clearly capable of functioning as claimed. Applicant argues that the heel of Lodispoto is raised, this is not true and

Art Unit: 3728

clearly shown otherwise in the drawings, see figures 2, 4, and 5. In reference to the extreme rear edge at 28, this portion merely cups the heel and does not support the bottom of the heel, portion at 24 clearly is the portion which supports and causes the heel of the wearer to be carried lower than the forefoot.

In response to applicants' arguments directed towards Snabb, Snabb clearly states that an insole is the layer which has the structure as claimed, this is specifically discussed and clearly disclosed in Snabb in column 3 lines 41-50 and column 4 lines 35-40. In reference to applicants' arguments directed towards figure 5, it is noted that figure 5 is merely a transvers cross sectional view and does not show the longitudinal variation of the thickness of the insole. Figure 2 clearly discloses an insole shaped as claimed. In reference to applicants arguments directed towards the extent i.e. $\frac{1}{2}$ way limitations, Snabb shows such inasmuch as applicant has shown such.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

Application/Control Number: 10/790,923

Page 10

Art Unit: 3728

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a long horizontal flourish extending to the right.

Marie Patterson
Primary Examiner
Art Unit 3728